

Appl. No. 10/737,313

Attorney Docket No. 8627-454
Client Reference No. PA-5379-CONRECEIVED
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FEB 26 2007

II. Remarks

Claims 1-22 and 25 stand rejected. Claims 1, 9, 11, 12, 16, and 18-20 are being amended, claims 4-6, 8, 10, 13-15, 17, and 21 are being cancelled, and claim 27 is being added. Accordingly, after entering this amendment, claims 1-3, 7, 9, 11, 12, 16, 18-20, 22, 25 and 27 remain pending.

Specifically, claims 1 and 19 have been amended to more clearly recite the claimed invention and now disclose a medical instrument comprising a housing having a passage through which a catheter is received, a cap having a recess formed therein and in fluid communication with the passage, and a valve body configured to fit within the recess. The valve body has a height dimension across the center of the valve body and a width dimension across the center of the valve body, the width dimension being less than the height dimension when the valve body is unstressed. The height and width dimensions of the valve body are unequal to the recess dimensions and define a plane perpendicular to the slits formed on the faces of the valve body. The valve body is configured to be compressed along the height dimension when received by the recess, defining a generally circular shape.

Claim 19 further recites a valve body having a slit plane extending internally from the first face and an opening extending internally from the second face, and an internal ring positioned within the valve body between the second face and the intersection between the opening and slit plane.

Additionally, claim 27 has been added. Claim 27 incorporates the subject matter of former claim 5 and amended claim 1, from which former claim 5 previously depended. Claim 27 further recites a valve body having a height dimension greater than the height dimension across the recess, as disclosed in paragraphs [0012],

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[0039], [0041], [0051], [0054], [0065], and Figure 2 of the Specification. Thus, no new matter has been added.

Reconsideration and re-examination of this application in view of the above amendments and the following remarks is herein respectfully requested.

Claim Rejections - 35 U.S.C. §102(b)

Responsive to the rejections of claims 1-8 and 10-17 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,610,665 to Matsumoto et al. (*Matsumoto*), *Matsumoto* does not teach each and every element of the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. For example, claims 1 and 27 recite a medical instrument comprising a valve body having a height dimension that is greater than the width dimension when the valve body is unstressed. When received within the recess, the valve body is compressed along the height dimension, defining a generally circular shape. Contrarily, the Examiner asserts that *Matsumoto* (in its Figures 24A-B) teaches a rectangular valve body (130) with slits (131, 132) that open in respective planar surfaces of the valve body. However, the valve body (130) is not compressed along the height dimension, and does not take a generally circular shape when received within the recess, contrary to the valve body recited in claims 1 and 27.

Further, claim 27 recites a valve body having a height dimension greater than the height dimension across the recess. Conversely, the valve body (130) does not have a height dimension greater than the height dimension across the recess, unlike the valve body recited in new claim 27. It appears that the Examiner has taken Figures 24A and 24B of *Matsumoto* to scale even though the reference does not

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claim the drawings are to scale. When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. MPEP §2125. *Matsumoto* does not disclose that the drawings are to scale and is silent as to dimensions. Therefore, it cannot be presumed that the length of valve body (130) is greater than the diameter of the recess. Accordingly, *Matsumoto* fails to teach each and every element of the claimed invention.

Responsive to the rejections under 35 U.S.C. 102(b) of claims 19-20, 22, and 25 as being anticipated by U.S. Patent No. 5,300,033 to Miller (*Miller*) and claims 19-22 as being anticipated by U.S. Patent No. 5,300,034 to Behnke et al. (*Behnke*), neither *Miller* nor *Behnke* teaches each and every element of the claimed invention. For example, claim 19 recites a medical instrument comprising a valve body having a height dimension that is greater than the width dimension when the valve body is unstressed. Neither reference discusses a valve body with a height dimension that is greater than the width dimension when the valve body is unstressed, as now recited in amended claim 19.

Further, claim 19 recites a valve body that is compressed along the height dimension when received within the recess, defining a generally circular shape. Neither *Miller* nor *Behnke* discloses a valve body compressed along the height dimension when received within the recess, defining a generally circular shape, as now recited in amended claim 19. Hence, neither *Miller* nor *Behnke* teaches each and every element of the claimed invention.

Accordingly, reconsideration of the rejections under 35 U.S.C. §102(b) and the allowance of claims 1, 19, and 27 are respectfully requested. Further, since claims 2, 3, 7, 9, 11, 12, 16, 18-20, 22, and 25 generally depend from claims 1, 19,

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or 27 the reasons for allowance of claims 1, 19, and 27 apply as well to the dependent claims.

Claim Rejections - 35 U.S.C. §103(a)

Claims 9 and 18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsumoto*. Claims 23 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Behnke* in view of U.S. Patent No. 5,409,463 to *Thomas et al. (Thomas)*. Since claims 9 and 18 depend from amended claims 27 and 1, respectively, the reasons for allowance of claims 1 and 27 apply as well to claims 9 and 18. Claims 23 and 24 have been cancelled. Accordingly, reconsideration of the rejections under 35 U.S.C. §103(a) and the allowance of claims 9 and 18 are respectfully requested.

Double Patenting

Responsive to the rejections of claims 4 and 13 under 37 CFR 1.75 should claims 1 and 10 be found allowable, claims 4 and 13 have been cancelled. Accordingly, the rejections of claims 4 and 13 are now moot.

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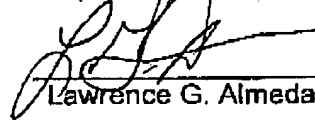
Conclusion

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims (claims 1-3, 7, 9, 11, 12, 16, 18-20, 22, 25, and 27) are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

February 26, 2007

Date



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